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EXAMINER

NELSON JR, MILTON

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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3636

DATE MAILED: 02/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/640,983

Applicant(s)

SNELSON, BILL

Examiner

Milton Nelson, Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) 6-8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

The information referred to in Applicant's information disclosure statement filed August 2, 2004 has been considered.

Specification

The title of the invention is not descriptive. The title appears directed to a trade name. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In line 9 of claim 2, "the support means" lack proper antecedent basis. Lines 6-7 of claim 3 are vague because it cannot be ascertained if Applicant intends to positively set forth "one" motorcycle accessory support, "or more"

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motorcycle accessory supports. In lines 3 to 4 of claim 4, Applicant sets forth "a support plate secured between the first and second legs of the U-shaped portion of the tubular support to define a platform for supporting a motorcycle seat cushion". It cannot be determined what structure represents this feature. This feature appears to be unsupported by the specification. In claim 4, it is unclear if Applicant intends to positively claim the combination of a seat assembly and a motorcycle passenger seat, or the subcombination of a seat assembly for use with a motorcycle passenger seat. Line 1 of the independent claim 3, from which claim 4 depends, appears to set forth the subcombination. Note the recitation a "seat assembly for a motorcycle equipped with a passenger seat". Lines 8-10 appear to set forth the combination. Note the recitation of the tubular support of the assembly being "mounted substantially adjacent to each side of a motorcycle passenger seat with the platform portion of the tubular support extending laterally from the motorcycle passenger seat". Line 8 of claim 4 is grammatically vague. Note the recitation "is mounted substantially adjacent to each side a motorcycle passenger seat". In line 9 of claim 4, it is unclear if "the platform portion" is intended to be the same feature as the previously set forth "a platform". Claim 5 is indefinite since it depends from indefinite claim 3.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

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(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(c) he has abandoned the invention.

(d) the invention was first patented or caused to be patented, or was the subject of an inventor's certificate, by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application for patent or inventor's certificate filed more than twelve months before the filing of the application in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

(f) he did not himself invent the subject matter sought to be patented.

(g)(1) during the course of an interference conducted under section 135 or section 291, another inventor involved therein establishes, to the extent permitted in section 104, that before such person's invention thereof the invention was made by such other inventor and not abandoned, suppressed, or concealed, or (2) before such person's invention thereof, the invention was made in this country by another inventor who had not abandoned, suppressed, or concealed it. In determining priority of invention under this subsection, there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

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Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Welsh (20020069464). Note the side seat cushion (10), side seat cushion support frame (3), side seat support (4), mounting means (6), the side seat cushion extending laterally from the motorcycle passenger seat (see Figure 9).

Claim 2, as best understood with the above cited indefiniteness, is rejected under 35 U.S.C. 102(b) as being anticipated by Welsh (20020069464). In Figure 5, note the at least one side seat cushion (right side 1), seat cushion support frame (right side 3), side seat support (right side 4), mounting means (6), fastening means (5, 5, left side member 3).

Claim 3, as best understood with the above cited indefiniteness, is rejected under 35 U.S.C. 102(b) as being anticipated by Welsh (20020069464). Note the pair of seat cushions (1, 1), seat cushion support frame (3), seat cushion support (4), mounting means (5, half of 6 for each side), and lateral extension (see Figure 9).

Allowable Subject Matter

Claims 4 and 5 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Election/Restriction

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Newly submitted claim 8 is directed to an invention that is independent or distinct from the invention originally claimed and elected for the following reasons:

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-5, drawn to a seat assembly, classified in class 297, subclass 250.1.
- III. Claim 8, drawn to a combination tour pack frame and seat assembly, classified in class 297, subclass 188.12.

The inventions are distinct, each from the other because of the following reasons:

Inventions III and I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because at least the U-shaped portion defining substantially parallel first and second legs is not required by the combination, wherein the feature is required by the subcombination. The subcombination has separate utility such as supplemental support structure for other than a motorcycle passenger seat.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for

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prosecution on the merits. Accordingly, claim 8 has been withdrawn from consideration as being directed to a non-elected invention.

Applicant elected Group I, Figure 2, claims 1-5 in the response filed June 23, 2004. The election was made without traverse. Claims 6 and 7 were non-elected. Claim 6 was subsequently treated since it was found to depend from allowable claim 3. The allowability of claim 3 has been withdrawn in view of newly discovered prior art. Such has necessitated the withdrawal from consideration of claim 6. In the response filed November 15, 2004, Applicant indicates that non-elected claim 7 belongs in the elected Group I. It does not appear that claim 7 should be grouped with the elected embodiment. Claim 7 sets forth a pair of support frames, each including seat cushion support means for supporting a motorcycle seat cushion. This appears to be the tubular supports 130, which support the cushion 131 in Figure 3 of Group II. As such, claim 7 was correctly withdrawn from consideration.

Response to Amendment/Arguments

Applicant's response has been fully considered. Remaining issues are outlined in the above sections.

Conclusion

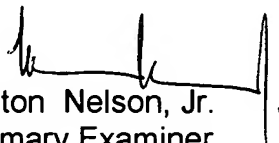
This office action has not been made final since it includes a new grounds of rejection not necessitated by Applicant's amendment.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Milton Nelson, Jr. whose telephone number is 7033082117. The examiner can normally be reached on Monday-Wednesday 5:30-3:00, and alternate Fridays 5:30-3:00.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Milton Nelson, Jr.
Primary Examiner
Art Unit 3636

mn
February 6, 2005